

REMARKS

Restriction requirement

In the Office Action of November 28, 2007 the Examiner asserts, in a restriction requirement, that the present application contains inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. The Examiner asserts that the present application contains three inventions—Group I, claims 1, 4-7, drawn to a composition containing an extract obtained by crushing and drying any one selected from Euphorbiae radix, gingered Magnolia bark, parched Puerariae radix and Glycyrrhizae radix; Group II, claims 2-7 drawn to a composition containing a mixture of extracts from Euphorbiae radix, gingered Magnolia bark, parched Puerariae radix and Glycyrrhizae radix; and Group III, claims 8-13, drawn to a composition comprising magnolol isolated from Magnolia bark. The Examiner further alleges that the claims of the application are directed to more than one species of the generic invention, and that the species encompass the different functions of the claims, which the Examiner lists to be the prevention and treatment of diabetic complications in claims 1-5, 8-11; and for the prevention and delay of aging in claims 6, 7, 12 and 13. The Applicant traverses this restriction of claims and species for the following reasons.

1. The Applicant submits that under PCT Rule 13.1, “*...a group of inventions so linked to form a single general inventive concept...*” fulfills the requirement of unity of invention. More specifically, under PCT Rule 13.2, the requirement is fulfilled “*...when there is technical relationship among those inventions involving one or more of the same or corresponding special technical features*”. The Applicant submits that the unity requirements in view of independent claims 1, 2, 3 and 8 are met according to the Written Opinion of the International Search Authority, a copy of which is enclosed for the Examiner’s reference, wherein these claims are grouped into group (i).

Additionally, the Applicant notes that while the Examiner of the International Searching Authority restricts some of the dependent claims (5, 7, 9, 11 and 13) for reciting a functional food in view of the composition recited in the independent claims, this does not void these dependent claims from having the same single general inventive concept. The Applicant submits

that all claims recite extracts from Magnolia bark. The Applicant notes that the species restriction between the treatment of diabetic complications and prevention of aging are linked by the claimed composition wherein all claimed compositions at least contain the single inventive concept in that all claim compositions recite extracts from Magnolia bark.

2. Furthermore, the Applicant reminds that Examiner that 35 USC § 121 authorizes, but **does not require**, the USPTO to restrict an application to one invention if two or more independent and distinct inventions are claimed in one application. In view of the expense that would be imposed upon the Applicant by multiple patent applications and multiple patents, it is believed that restriction requirements should be issued only when absolutely necessary.

3. The Examiner is respectfully reminded of MPEP 803, which states that

"If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions."

In the case at issue, there is no serious burden in examining 13 claims, of which all belong to the same technological class. This position is further substantiated by the International Searching Authority for this application which marked the box numbered 2 in Box No. III. That box reads, *"As all searchable claims could be searched without effort justifying an additional fee, this Authority did not invite payment of any additional fee."* This page of the International Search Report is enclosed with this response.

4. The Applicant submits that the restriction requirement set forth in the Office Action of November 28, 2007 is improper. As such, reconsideration is respectfully requested and the Examiner is respectfully requested to withdraw the restriction requirement. However, as required under 35 USC § 121, Applicant *provisionally* elects Group II, claims 2-7, and *provisionally* elects the species found in claims 2-5 for prevention and treatment of diabetic complications.

5. Additionally, Applicants expect the Examiner to use a consistent test with respect to what matters are obvious and what matters are unobvious throughout the prosecution of this

application. Because the Examiner is adopting a particular standard for patentability in this case in terms of the election/restriction requirement, Applicants will expect that the same test be used throughout the prosecution of this application if the Examiner does not withdraw the election/restriction requirement made in the official action.

Conclusion

The traversal of the restriction requirement and the remarks regarding the traversal are being submitted without prejudice. In view of the above, allowance of the pending claims is respectfully solicited.

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The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this paper (and any enclosure referred to in this paper) is being transmitted electronically to the United States Patent and Trademark Office on

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(Date of Deposit)

Stacey Dawson
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Signature
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Date

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Enclosures: Written Opinion by ISA (7 pages)
International Search Report page 2 (1 page)